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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,686	05/23/2000	Paul B. Darcy	MFCP.70154	3725

45809 7590 08/21/2006

SHOOK, HARDY & BACON L.L.P.  
(c/o MICROSOFT CORPORATION)  
INTELLECTUAL PROPERTY DEPARTMENT  
2555 GRAND BOULEVARD  
KANSAS CITY, MO 64108-2613

EXAMINER
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JABR, FADEY S

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/576,686	<b>Applicant(s)</b> DARCY ET AL.	
	<b>Examiner</b> Fadey S. Jabr	<b>Art Unit</b> 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-20,30,32-35 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-20,30,32-35 and 43-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Status of Claims***

Claim **45** has been added. Claims **1, 19, 20, 34 and 35** have been amended. Claims **1, 3-20, 30, 32-35 and 43-45** remain pending and are again presented for examination.

### ***Response to Arguments***

1. Applicant's amendments (with respect to claims 1, 19 and 34) filed 14 June 2006, with respect to the 35 U.S.C. 112, second paragraph, rejection have been fully considered and are therefore withdrawn.
2. Applicant's amendments (with respect to claims 20 and 35) filed 14 June 2006, with respect to the 35 U.S.C. 112, second paragraph, rejection have been fully considered but they are not persuasive. Claims 20 and 35 remain objected to for the following: A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim. See MPEP § 608.01(n), Section III. However, the depending claims 20 and 35 recite "A computer system having a processor, an operating system, a memory, the computer system being operable to perform the steps recited in claim 1 (30)." Applying the infringement test, what is needed to infringe claims 20 and 35 is, for example, a computer system having a processor, operating system and memory that if and when executed would cause a computer to do the identifying, determining and summing steps. However, such a computer system would not infringe the method steps of claims 1 and 30 since the computer system itself never performs any of the active steps of identifying, determining and summing required by the method. In other words, mere possession of such a computer system would infringe claims 20 and 35, but this is

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not enough to infringe claims 1 and 30. As a result, claims 20 and 35 are an improper dependent claims. To overcome the objection to claims 20 and 35 would require the Applicant to rewrite the claims in independent form.

3. Applicant's arguments filed 14 June 2006, with respect to the 35 U.S.C. 102(e) rejection have been fully considered but they are not persuasive.

4. Applicant's arguments filed 14 June 2006, with respect to the 35 U.S.C. 103(a) rejection have been fully considered but they are not persuasive.

5. Applicant argues (with respect to claims 1, 19-20, 30, 34-35 and 44) that Saari et al. fails to disclose identifying one or more information technology services utilized to execute the computer transaction. Examiner notes that Saari discloses a system and method for implementing a flexible and effective charging capability that accounts for the particular use of a network service connections and other **resources by users of a network** (C. 1, lines 62-67).

Saari further discloses billing cells that contain billing and connection information. The information (resources utilized) is used produce billing information (C. 2, lines 1-20). Moreover, the node computes the cost of using the connection based on the billing and connection information. (identifies the resources and costs associated). Furthermore, Saari discloses the nodes also transmit their respective charging information to a common network billing system that generates the **total charge** in a final bill that is forwarded to the user (C. 2, lines 27-30, C. 7, lines 20-27). Therefore the billing information identifies the information technology services utilized to execute the computer transaction.

6. Applicant argues (with respect to claim 3) that Saari fails to disclose calculating the equipment cost as a percentage of an overall equipment cost for equipment utilized to execute

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the transaction. However, Examiner noted that Saari failed to explicitly disclose the above limitation. Nevertheless, Saari discloses implementing charging strategies for determining the cost of using network connections and other **resources**. Moreover, Saari discloses a charging strategy that takes into consideration a number of service factors (along with the amount of bandwidth provided [equipment utilized]) which impact the performance of network resources (C. 4, lines 18-42). Therefore taking into consideration a number of resources to provide the service, requires that the system factor each resource into an overall resource cost.

7. Applicant argues (with respect to claims 13 and 33) that Saari fails to disclose determining a cost for the quality of service includes determining a cost of the response time of the one or more service and availability cost. Examiner notes that Saari discloses an availability of the resource (C. 4, lines 18-35, C. 9, lines 2-26, 46-55). Further, Examiner notes that taken in its broadest reasonable interpretation response time is a performance parameter used in characterizing a service. Therefore, Saari discloses other types of information (e.g. response time) can be used to characterize the performance of the service (C. 6, lines 2-6).

8. Applicant argues (with respect to claims 4-6, 9-12, and 14-17) that Saari and Ginter et al. fail to disclose software cost, facility costs, equipment cost and personnel cost calculated as a percentage of an overall software, facility, equipment and personnel cost. However, Examiner notes that equipment taken in its broadest reasonable interpretation equipment encompasses many forms of equipment, such as software, facility, and personnel. Equipment costs would therefore include software, facility and personnel costs.

***Claim Objections***

9. Claims **20 and 35** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. A computer system does not actively perform the method steps and are therefore in improper dependent form. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims **1, 7, 8, 18-20, 30, 32, 34-35, 43 and 44** are rejected under 35 U.S.C. 102(e) as being anticipated by Saari et al., U.S. Patent No. 6,338,046 B1.

As per **Claims 1, 19 and 20**, Saari et al. discloses a method comprising:

- identifying one or more underlying services utilized to execute the computer transaction (Col. 2, lines 1-20);
- determining a monetary service providing cost associated with the one or more services utilized to execute the transaction, wherein determining the monetary service providing cost comprises,

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- identifying each resource utilized to provide the one or more services,  
(Col. 2, lines 1-20);
- assigning a portion of the monetary service providing cost of each resource to  
the computer transaction, (Col. 2, lines 1-20) and;
- summing the monetary service providing cost for each resource to determine the  
monetary cost for the computer transaction in order to pass the monetary cost for the  
computer transaction to a user executing the computer transaction  
(Col. 7, lines 20-27).

As per **Claim 7**, Saari et al. further discloses a method wherein the determining step includes determining a cost for a level of quality of the one or more services utilized to execute the transaction (Col. 4, lines 18-35; Col. 9, lines 2-26).

As per **Claim 8**, Saari et al further discloses a method wherein the step of determining a cost for the quality of the service includes determining a cost for the availability of the one or more services (Col. 4, lines 18-35; Col. 9, lines 2-26, 46-55).

As per **Claim 18**, Saari et al. further discloses a method wherein the determining step includes  
  
determining a cost for a level of quality of the one or more services utilized to execute the transaction, the method further including the step of combining the monetary service providing

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cost and the quality cost to define the monetary computer transaction cost (Col. 5, line 56 – Col. 6, line 6).

As per **Claim 30, 34 and 35**, Saari et al. discloses a method comprising:

- requesting, by a user process, execution of a transaction (Col. 4, lines 3-17);
- receiving, by one or more service processes, the user process request (Col. 4, lines 3-17);
- executing, by the one or more service processes, the user process request (Col. 4, lines 3-17); and
- determining, by the one or more service processes, a monetary service provider cost associated with the execution of the transaction as a function of the services utilized to execute the transaction, wherein determining the monetary service provider cost comprises identifying each resource utilized to provide the service and assigning a portion of the monetary service provider cost of each resource to the computer transaction in order to pass the monetary service provider cost to the user executing the computer transaction (Col. 2, lines 1-20; Col. 7, lines 20-27).

As per **Claim 32**, Saari et al. further discloses a method wherein the determining step includes

determining a quality cost of the one or more services associated with the execution of the transaction (Col. 4, lines 18-35; Col. 9, lines 2-26).



As per **Claim 43**, Saari et al. discloses a method comprising:

- identifying a fixed cost resource and attributing a portion of a total monetary service providing cost for the fixed cost resource to the computer transaction (Col. 2, lines 1-20, 32-34), and
- identifying variable cost resources and determining a portion of the variable cost resources required to conduct the transaction (Col. 2, lines 1-20, 32-34); and
- summing a monetary service providing cost for the fixed cost resource and a monetary service providing cost for the variable cost resource to determine the monetary cost for the computer transaction (Col. 2, lines 32-34).

As per **Claim 44**, Saari et al. further discloses a method comprising:

- a service identification component for identifying any services necessary for conducting the computer transaction (Col. 1, lines 1-20; Col. 7, lines 20-27);
- a resource identification component for identifying resources utilized in providing each service (Col. 1, lines 1-20; Col. 7, lines 20-27); and
- a cost assessment component for determining a monetary cost to a provider for each resource and determining the monetary cost for the computer transaction based on a total monetary service provider cost for each utilized resource (Col. 1, lines 1-20; Col. 7, lines 20-27).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims **3, 13 and 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Saari et al, U.S. Patent No. 6,338,046 B1.

As per **Claim 3**, Saari et al. discloses a method wherein equipment is a utilized resource and the monetary service providing cost includes an equipment. Saari et al fails to disclose calculating the equipment cost as a percentage of an overall equipment utilized to execute the transaction. However, Saari et al. discloses a charging strategy that takes into account a number of service factors which impact performance (Col. 4, lines 18-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method Saari et al. and include calculating the equipment cost as a percentage of an overall percentage cost, because it allows the providing service to track which equipment are being utilized to impact performance.

As per **Claim 13 and 33**, Saari et al. discloses wherein the step of determining a quality cost includes determining an availability cost (Col. 4, lines 18-35; Col. 9, lines 2-26, 46-55). Saari et al. fails to disclose a method wherein the step of determining a cost for the quality of the service includes determining a cost of the response time of the one or more services. However,

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Saari et al. discloses other types of information can be used to characterize the performance of the connection information carried by the billing cell (Col. 6, lines 2-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Saari et al. and include the cost of the response time of the one or more services, because it allows the providing service to charge the user for the general level of service which user requires (Col. 5, lines 56-64).

14. Claims **4-6, 9-12 and 14-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Saari et al., U.S. Patent No. 6,338,046 B1 in view of Ginter et al., Pub. No. US2005/0060584 A1.

As per **Claims 4-6, 9-12, 14-17 and 45**, Saari et al. fails to disclose a method wherein availability cost and response time cost include software cost, facility cost, equipment cost and personnel cost, wherein the costs are calculated as a percentage of an overall software cost, overall facility cost, overall equipment cost and an overall personnel cost. However, Ginter et al. teaches costs for providing services to a user include an equipment and related costs (electricity, personnel, maintenance, etc.) (Para. 637). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Saari et al. and include software costs, facility costs, equipment costs and personnel costs as an overall resource usage cost of providing the transaction to the user, because the providing service will charge the user according to their service class type which allows the service provider to bill the user according to their network resource usage (Saari et al., Col. 4, lines 31-42).

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr  
Examiner  
Art Unit 3639

FSJ

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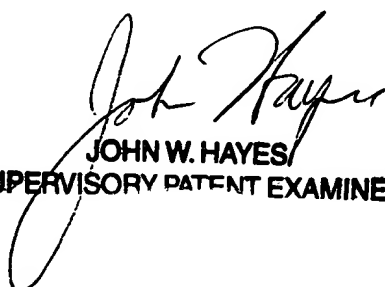
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Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

  
**JOHN W. HAYES**  
**SUPERVISORY PATENT EXAMINER**